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APPLICATION NO. 5044	FILING DATE 7/7/98	FIRST NAMED INVENTOR DANIEL L DAWES	ATTORNEY DOCKET NO.
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DANIEL L DAWES
5252 KENILWORTH DRIVE
HUNTINGTON BEACH CA 92649

COHEN EXAMINER

ART UNIT 3736	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 3736

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 - "said vascular cavity" in lines 9 and 12 lack antecedent basis. Claim 30 - "said vascular cavity" in line 4 lacks antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 26, 28, 30, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Anderson et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. The use of markers is well known in the art and would have been an obvious design expedient to use in Anderson et al.

Art Unit: 3736

Claims 29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Chee et al. The basic device including a detachable coil is disclosed by Anderson et al. The addition of filaments to a coil to effect the occlusion is disclosed by Chee et al. It would have been obvious to add such filaments to the Anderson et al coil to form a superior occlusion. The particular coupling means is disclosed by applicant to have been known.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-34 are rejected under the judicially created doctrine of double patenting over claims 1-10 of U. S. Patent No. 5,540,680 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a method and apparatus including a plurality of filaments.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

Art Unit: 3736

which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

This application filed under former 37 CFR 1.60 lacks the necessary reference to all the prior applications. The statement following the title of the invention or as the first sentence of the specification should reference all prior applications. Also, the current status of all nonprovisional parent applications referenced should be included.

The information disclosure statement referenced in the request for filing the application under 37 CFR 1.60 was not enclosed. It should be submitted with the response to this action.

Any inquiry concerning this communication should be directed to Lee S. Cohen at telephone number (703) 308-2998.



Lee Cohen
Primary Examiner